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Black Lowe & Graham, PLLC  
701 Fifth Avenue  
Suite 4800  
Seattle, WA 98104

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**OFFICE OF PETITIONS**

In re Application of	:	OFFICE OF PETITIONS
Odinak et al.	:	
Application No. 10/689,504	:	
Filed: October 21, 2003	:	
Attorney Docket No. INTL-1-1038	:	
	:	DECISION ON PETITION
In re Application of	:	
Odinak et al.	:	
Application No. 11/820,066	:	
Filed: June 5, 2006	:	
Attorney Docket No. INTL-1-1049	:	

This is a decision on the petition filed on February 21, 2007, requesting that an improper Continued Prosecution Application (CPA) under 37 CFR 1.53(d) be treated as an application under 37 CFR 1.53(b) and be accorded a filing date of June 5, 2006.

On February 22, 2006, a Notice of Allowance and Fee(s) Due and a Notice of Allowability were mailed in application No. 10/689,504, which set a three (3) month statutory period for reply. In response, on May 19, 2006, applicants paid the issue fee and publication fee. Thereafter, on June 5, 2006, applicants submitted a request for a CPA under 37 CFR 1.53(d) based on prior application No. 10/689,504, accompanied by a copy of the original application papers. On August 15, 2006, application No. 10/689,504 issued as U.S. Patent No. 7,092,816.

The Office notes that at the time the CPA was filed CPA practice no longer applied to applications, other than design applications.<sup>1</sup> Accordingly, the CPA request was improper. See 37 CFR 1.53(d)(1).

On February 21, 2007, applicants filed the present petition. Applicants stated that they submitted a copy of "the nonprovisional utility continuation patent application as transmitted via the EFS-Web system and received by the USPTO on June 5, 2006," with the petition. However, it appears that the applications papers provided with the petition are not identical to the copy of the original application papers submitted with the CPA on June 5, 2006. Therefore, the Office will process the application using the copy of the application papers filed on June 5, 2006.

In the event that an applicant files a request for a CPA that does not meet the requirements of 37 CFR 1.53(d) because the application is not a design application, and the application was filed on or after June 8, 1995, the request for a CPA will be treated as an RCE under 37 CFR 1.114.

The Office will no longer convert an improper CPA to an application under 37 CFR 1.53(b) simply because an applicant requests it. The Office will convert an improper CPA to an application under 37 CFR 1.53(b) only if applicant demonstrates that "there are extenuating circumstances that warrant the burdensome process of converting a CPA into an application under Sec. 1.53(b) (e.g., restoring the application to pending status and correcting the improper RCE is not possible because the application has issued as a patent)."

*Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications, 68 FR 32376 (May 30, 2003), 1271 Off. Gaz. Pat. Office 143 (June 24, 2003) (final rule).*

The Office finds that extenuating circumstances warrant the process of converting the CPA to an application under 37 CFR 1.53(b). Accordingly, the petition is granted.

The continuation application under 37 CFR 1.53(b) filed on June 5, 2006, has been assigned application No. 11/820,066. The CPA request and the application papers have been removed from the file of application No. 10/689,504 and have been placed in application No. 11/820,066. Copies of the CPA request and the present petition will be retained in application No. 10/689,504 to complete the record therein. All further correspondence concerning the

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<sup>1</sup>Effective July 14, 2003, the Office eliminated CPA practice as to utility and plant applications. See *Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications, 68 FR 32376 (May 30, 2003), 1271 Off. Gaz. Pat. Office 143 (June 24, 2003) (final rule)*.

continuation application under 37 CFR 1.53(b) should be directed to application No. 11/820,066, not application No. 10/689,504.

The Office finance records will be corrected to show that the filing, search, and examination fees totaling \$425.00 were paid in application No. 11/820,066 on June 5, 2006. The \$400.00 petition fee will not be refunded because the filing of the present petition was not necessitated by any error on the part of the USPTO.

Application No. 11/820,066 will be forwarded to the Office of Initial Patent Examination for further processing as a continuation application of prior filed application No. 10/689,504, with a filing date of June 5, 2006, using the application papers filed on June 5, 2006.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Christina Tartera Donnell at (571) 272-3211.



Eugenia A. Jones  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy